

### **REMARKS**

In response to the Office action mailed February 22, 2005, Applicant hereby submits the foregoing amendment. Claims 5, 13, 15 and 16 have been amended. Claim 12 has been cancelled. New claims 17-20 have been added. The claims, as amended, are therefore believed to be in condition for allowance.

#### **Title**

The Title of the invention has been amended to clearly indicate the invention to which the claims are directed. The term "Articles" has been changed to "Containers." Accordingly, Applicant respectfully submits that the Examiner's rejection be withdrawn.

#### **Claim Rejections – 35 U.S.C. § 112, second paragraph**

In the Office Action, claims 5 and 12 were rejected as being indefinite under 35 U.S.C. § 112, second paragraph. Claim 5 has been amended to recite that the second material "cures" to form the barrier layer. That is, the feature has been positively claimed. Applicant respectfully requests that the rejection be withdrawn. Claim 12 has been cancelled. Accordingly, Applicant respectfully submits that the Examiner's rejection is moot.

#### **Claim Rejections – 35 U.S.C. § 103**

Claims 1-4, 6, 8-12, 15 and 16 were rejected under 35 U.S.C. § 103(a) over U.S. patent 3,740,259 to Carl et al (Carl) in view of U.S. patent 4,667,620 to White. This rejection is respectfully traversed.

Claims 1, 13, 15 and 16, as amended, each recite the step of prior to coating, covering portions of the containers to remain uncoated with *shields made from scraps of the first material produced from the making of the containers*. As described in the instant application, typically containers hang from supporting chucks on a conveyor chain and are moved through a coating spraying station. Shields for protecting the threads from the coating are currently being used, but these shields are machined from nylon at a current cost of approximately \$10 each. Due to the buildup of the coating plastic, the sprayed coating must be removed from the shields, a very labor intensive process. The nylon shields must be cleaned approximately every five days, thus resulting

in additional shutdowns of the line. There are thousands of shields, for example, 6000 shields, on each conveyor line. Despite the cleaning, hundreds, for example, 500 - 700, of these shields must be replaced each month. By the present invention, the shields are made from a material that slows the accumulation of the sprayed coating material. As a result, downtime of the line just for replacement of the shields is eliminated. More specifically, the shields are made from scraps of the material used to make the containers and are simply pulled off the chucks, disposed of and replaced during shutdowns. The invention thus reduces material costs as well as losses resulting from shutdowns.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See M.P.E.P. § 2143.

The primary reference, Carl, describes a chuck apparatus comprising a main body member 10 that may be fabricated from a variety of conventional materials including plastics (see column 2, line 61 – column 3 line 1). As pointed out by the Examiner, Carl “does not explicitly state the material making up the masking/shielding means is the same as, and made from scrap of, the containers....” The Examiner cites White as teaching the “concept of coating certain portions of a container while shielding other portions from the coating material” and further states that White teaches that “containers must be recyclable due to state and federal mandates, and that PET material is recyclable” (see page 4 of the Office action). Applicant respectfully traverses the rejection based on lack of motivation to combine the references and, in any event, failure to teach all the claim limitations.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Moreover, the level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999). Neither Carl nor White teaches *shields*

*made from scraps of the first material produced from the making of the containers.* Thus, there is no suggestion or motivation to modify or combine the references. The Office Action has impermissibly used Applicant's own disclosure to reconstruct the claimed invention. Even assuming, *arguendo*, that the combination of Carl in view of White was proper, the combination does not teach all the claim limitations. Specifically, neither reference teaches that the shields are made from scraps of the first material as now recited in each of claims 1, 13, 15 and 16.

Notably, the Office Action goes on to state that "[t]he recycling of scrap material from a PET container-making operation would therefore have been an obvious variation given the teachings of White because there is simply no reason to expect that formed containers and scrap from making the same formed containers would have any difference in their ability to be recycled and reformed, absent a **clear and convincing** showing to the contrary" (see page 4 of the Office action) (emphasis added). It is respectfully submitted that the Office Action misstates the burden for presenting a prima facie case of obviousness. Pursuant to M.P.E.P. § 2142, the initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. Applicant submits that the ultimate determination of patentability must be based on the entire record, by a **preponderance of evidence**, with due consideration to the persuasiveness of any arguments and any secondary evidence. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992) (emphasis added).

Claims 5, 7, 13 and 14 were rejected under 35 U.S.C. § 103(a) over Carl in view of White, as discussed above, further in view of the known prior art discussed in the Background section of the instant patent application. This rejection is respectfully traversed. Nevertheless, claims 5 and 7 depend from claim 1 and are, therefore, submitted as being allowable based on the foregoing arguments. Claim 13 has been amended to include that the ***shields are made from scraps of the first material produced from the making of the containers*** and is believed to be allowable. Claim 14 depends therefrom.

New claims 17-20 have been added to recite that *the shields do not hold a threaded engagement portion of a finish of the containers*. Both Carl and White fail to teach such a shield. Carl, for example, clearly shows the shield 10 holding a container 12 by threaded engagement therewith (see figure 1).

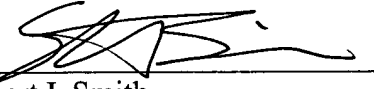
**Conclusion**

Claims 1-11 and 13-20 are believed to be in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is hereby invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Reply is respectfully requested.

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Respectfully submitted,

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